

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BEATRICE TOUMI,  
JEAN-CLAUDE GARSON, and NATHALIE MOUGIN

Appeal No. 2004-1994  
Application No. 09/533,361

HEARD: December 7, 2004



Before WILLIAM F. SMITH, ADAMS, and GRIMES, Administrative Patent Judges.

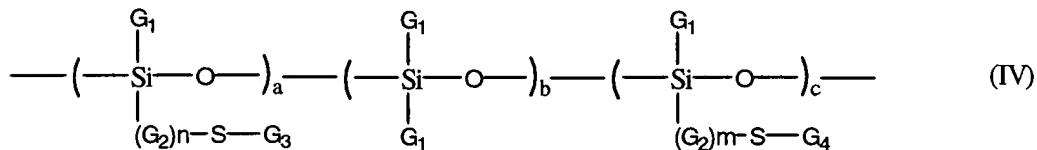
ADAMS, Administrative Patent Judge.

#### REMAND TO THE EXAMINER

On consideration of the record, and appellants' oral arguments, we find this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

Claims 1-3, 17-22 and 24-47 are pending in the application. Claims 1<sup>1</sup>, 17, 19, 20<sup>2</sup>, 21<sup>3</sup>, 27, are illustrative of the subject matter on appeal and are reproduced below:

1. A method for reducing the signs of cutaneous aging, comprising applying onto skin comprising signs of cutaneous aging a composition comprising an amount of at least one grafted silicone polymer effective to reduce signs of cutaneous aging, wherein said grafted silicone polymer comprises a polysiloxane portion and a portion comprising a non-silicone organic chain, one of the two portions constituting a main chain of the polymer and the other being grafted to the main chain, wherein the grafted silicone polymer is a polymer with a polysiloxane backbone grafted by at least one non-silicone organic monomer and comprises, in its structure, the unit of following formula (IV):



in which the G<sub>1</sub> groups, which are identical or different, represent hydrogen or a C<sub>1</sub>-C<sub>10</sub> alkyl group or alternatively a phenyl group; the G<sub>2</sub> groups, which are identical or different, represent a C<sub>1</sub>-C<sub>10</sub> alkylene group; G<sub>3</sub> represents a polymeric group prepared by the (homo)polymerization of at least one anionic monomer with ethylenic unsaturation; G<sub>4</sub> represents a polymeric group prepared by the (homo)polymerization of at least one hydrophobic monomer with ethylenic unsaturation; m and n are, independently of one another, equal to 0 or 1; a is an integer ranging from 0 to 50; b is an integer which can be between 10 and 350[;] and c is an integer ranging from 0 and 50, with the proviso that one of the parameters a and c is other than 0.

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<sup>1</sup> We note that independent claim 3 differs from claim 1 only in that the method of claim 3 is directed to a "method for reducing wrinkles comprising applying onto skin comprising wrinkles a composition comprising a wrinkle-reducing effective amount of at least one grafted silicone polymer."

<sup>2</sup> The composition of independent claim 34 differs from the composition of claim 20 only in that the amount of the polymer in the composition is effective for reducing "signs of cutaneous aging" rather than wrinkles as set forth in claim 20.

<sup>3</sup> The composition of independent claim 35 differs from the composition of claim 21 only in that the amount of the polymer in the composition is effective for reducing "signs of cutaneous aging" rather than wrinkles as set forth in claim 21.

17. The method of Claim 1, wherein the unit of formula (IV) has at least one of the following:
  - $G_1$  is a  $C_1$ -[ $C_{10}$ ] alkyl group;
  - $n$  is not zero and  $G_2$  is a divalent  $C_1$ - $C_3$  group;
  - $G_3$  is a polymeric group prepared by the (homo) polymerization of at least one monomer comprising a carboxylic acid group and having ethylenic unsaturation;
  - $G_4$  is a polymeric group prepared by the (homo) polymerization of at least one ( $C_1$ - $C_{10}$ ) alkyl (meth)acrylate monomer.
19. The method of [c]laim 1 or 3, wherein the grafted silicone polymer comprises from 0.03 to 25% of the total weight of the composition.
20. A composition comprising, in a physiologically acceptable medium, (1) a wrinkle-reducing effective amount of at least one grafted silicone polymer comprising a polysiloxane portion and a portion comprising a non-silicone organic chain, one of the two portions constituting the main chain of the polymer and the other being grafted to the said main chain and (2) one or more plant proteins.
21. A composition comprising, in a physiologically acceptable medium, (1) a wrinkle-reducing effective amount of at least one grafted silicone polymer comprising a polysiloxane portion and a portion comprising a non-silicone organic chain, one of the two portions constituting the main chain of the polymer and the other being grafted to the said main chain and (2) one or more slimming, firming, antiglycant and/or vasoprotective compounds.
27. The method of [c]laim 1, further comprising allowing said composition to remain on the skin after said applying, thereby forming a film.

The references relied upon by the examiner are:

Kumar et al. (Kumar)	5,468,477	Nov. 21, 1995
Hasenoehrl et al. (Hasenoehrl)	6,190,678	Feb. 20, 2001
Delrieu et al. (Delrieu)	6,319,507	Nov. 20, 2001

#### GROUNDS OF REJECTION

Claims 1-3, 17-19, 24-29 and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar.

Claims 20, 34, 36, 40 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of Delrieu.

Claims 21-22, 30, 35, 37-39, 41-45 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of Hasenoehr.

For the following reasons we remand the case to the examiner for further consideration.

### DISCUSSION

#### 1. What claims are on appeal:

According to appellants (Brief, page 2), “[c]laims 1-3, 17-22 and 24-47 are pending, although [a]ppellants have submitted a supplemental amendment herewith requesting cancellation of claim 2[, and amending claims 17, 19, 22, 25 and 26].” Apparently, appellants expected the examiner to enter this “supplemental amendment” since the claims listed in the Appendix of appellants’ Brief includes the amendments presented therein, and do not include a copy of claim 2. However, despite the examiner’s statement (Answer, page 2), “[t]he copy of the appealed claims contained in the Appendix to the Brief is correct,” there is no indication on this record that the examiner considered appellants’ supplemental amendment, dated January 8, 2004.

Thus, it appears that a number of claims presented in the Appendix of appellants’ Brief, are not properly before us for review. In addition, appellants do not identify the rejection of claim 2 as an issue that should be before this panel for review. Accordingly, we remand the application to examiner to

reconsider the prosecution history to determine the correct status of each claim on appeal. After having an opportunity to review the prosecution history, the examiner should take appropriate action to clarify the status of each claim on appeal.

2. The evidence and reasoning in support of the obviousness rejections:

As set forth in Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1033 (Fed. Cir. 1997), “[f]or an appellate court to fulfill its role of judicial review it must have a clear understanding of the grounds for the decision being reviewed,” which requires that “[n]ecessary findings must be expressed with sufficient particularity to enable [the] court without resort to speculation, to understand the reasoning of the board, and to determine whether it applied the law correctly and whether the evidence supported the underlying and ultimate fact-findings.” Like the Court of Appeals in Gechter, this Board requires a clear understanding of the grounds for the decision being reviewed. In this case, we find it difficult to understand the examiner’s reasoning and whether the evidence upon which he relies supports the underlying fact-findings for the rejections under 35 U.S.C. § 103.

The examiner’s discussion of the rejection of claims 1-3, 17-19, 24-29 and 31-33 under 35 U.S.C. § 103 over Kumar focuses on formula IV as set forth, for example, in appellants’ claim 1. According to the examiner (Answer, bridging paragraph, pages 3 and 4), Kumar discloses the grafted silicone polymers as set forth in formula IV, including the substituents for “G3” and “G4” of this formula.

The examiner, however, fails to direct our attention to any portion of Kumar, where evidence supporting this assertion can be found.

At best, the examiner directs our attention to a face cream that is “exemplified” in Kumar. Answer, page 4. While the examiner does not direct our attention to any particular example, we believe the examiner is referring to Example 27 on column 30 of Kumar. The face cream composition of Example 27 refers to a polymer described in Example 3. Example 3 of Kumar refers to the “[p]reparation of [a] copolymer using [m]ercapto [f]unctional [s]ilicon (PS850), [e]thylhexyl methacrylate (EHM), and i-[b]utyl [m]ethacrylate (IBM).” See Kumar, column 26. Appellants’ specification (page 9) describes ethylhexyl methacrylate, and i-butyl methacrylate as “hydrophobic monomers.”

By way of example, we direct the examiner’s attention to appellants’ claim 1. Appellants’ claim 1 (emphasis added) requires that the G<sub>3</sub> substituent of formula IV “represents a polymeric group prepared by the (homo)polymerization of at least one anionic monomer with ethylenic unsaturation;” and the G<sub>4</sub> substituent of formula IV “represents a polymeric group prepared by the (homo)polymerization of at least one hydrophobic monomer with ethylenic unsaturation.” Appellants’ specification (page 9) describes ethylhexyl methacrylate, and i-butyl methacrylate as “hydrophobic monomers.”

Accordingly, it is unclear how example 3 of Kumar relates to formula IV, which requires two different polymeric groups, the first prepared by the (homo)polymerization of at least one anionic monomer with ethylenic unsaturation; and the second prepared by the (homo)polymerization of at least

one hydrophobic monomer with ethylenic unsaturation. While, the examiner appears to acknowledge this deficiency in Kumar<sup>4</sup>, the examiner fails to direct our attention to a portion of Kumar that would suggest the grafted silicone polymer set forth in formula IV of appellants' claimed invention. See e.g., formula IV, appellants' claim 1.

We recognize, however, that the compositions set forth in claims 20, 21, 34 and 35 are not limited to a particular grafted silicone polymer. As set forth above, the examiner rejected these claims under 35 U.S.C. § 103 over Kumar in combination with Hasenoehrl (claims 21 and 35), or Delrieu (claims 10 and 34). The examiner relies on Hasenoehrl (Answer, page 5), to make up for Kumar's failure to teach "slimming, firming, antiglycant and/or vasoprotective compounds." Similarly, the examiner relies on Delrieu (Answer, page 6), to make up for Kumar's failure to teach "plant proteins."

Nevertheless, the examiner fails to specifically address how Kumar would apply to the grafted silicone polymer set forth in claims 20, 21, 34 and 35. Rather than explaining how Kumar applies to the rejected claims, the examiner directs our attention to the findings of fact set forth in the rejection of claim 1-3, 17-19, 24-29 and 31-33 discussed above. However, as set forth above, the examiner has not adequately explained the basis of this rejection. Accordingly, it

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<sup>4</sup> See Answer, page 4, wherein the examiner finds "[t]he reference lacks an exemplification of a skin composition comprising a grafted silicone copolymer comprising at least one anionic non-silicone organic monomer and at least one hydrophobic non-silicone organic monomer."

is unclear from the examiner's statement of rejection, how Kumar applies to the compositions set forth in claims 20, 21, 34 and 35.

In addition, we note that claim 42 depends from claim 36, which ultimately depends from claim 20. In rejecting these claims the examiner finds that claim 20 is unpatentable over Kumar, claim 36 is unpatentable over Kumar in view of Delrieu, and claim 42 is unpatentable over Kumar in view of Hasenoehrl. Since claim 42 encompasses all of the limitations of claims 20 and 36, it is unclear from this record why the examiner did not include at least claims 36 and 42 in the same rejection.

On reflection, we find that the statements of rejections as they appear on this record are not susceptible to meaningful review. The rejections encompass a plurality of claims but do not state with any specificity why any individual claim is unpatentable. The rejections focus on appellants' formula IV, while providing no evidentiary basis as to how the reference applies to the particular formula, or the rejected claims.

Therefore, we remand the case for further consideration. Prior to any further action on the merits, we encourage the examiner to take a step back and reconsider the claimed invention in light of the available prior art. In this regard, we remind the examiner that the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound

obvious."); In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (Federal Circuit has "decline[d] to extract from Merck[ & Co. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that ... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it."). See also In re Deuel, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995).

To the contrary, in order to establish a prima facie case of obviousness in a genus-species situation, as in any other 35 U.S.C. § 103 case, it is essential that examiner find some motivation or suggestion to make the claimed invention in light of the prior art teachings. See, e.g., In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) (the mere possibility that the prior art could be modified such that it would lead to the claimed invention does not make the claimed process obvious unless the prior art suggested the desirability of such a modification); In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) ("[A] proper analysis under § 103 requires, inter alia, consideration of ... whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process.").

If, after having an opportunity to reconsider the record, the examiner is of the opinion that the claims are unpatentable under 35 U.S.C. § 103, the examiner should issue an appropriate Office action which sets forth the facts and reasons used in support of such a rejection. Further, we recommend the examiner review MPEP § 706.02(j) for a model of how to explain a rejection

under section 103 of the statute. Adherence to this model will of necessity require that the examiner consider the patentability of the claims in an individual manner and set forth the facts and reasons in support of why individual claims are unpatentable.

### OTHER ISSUES

#### 1. Claims 27-29 appear to be substantial duplicates:

Claims 27-29<sup>5</sup> on appeal are exactly the same. Specifically, while the claim numbers differ, each claim is drawn to “[t]he method according to [c]laim 1, further comprising allowing said composition to remain on the skin after said applying, thereby forming a film.” It may be that appellants intended claims 27-29 to depend from claims 1-3 respectively. See the After Final amendment received May 8, 2002, requesting, inter alia, that claims 27-29 be added. This After Final amendment, however, was not entered.<sup>6</sup> See Advisory Action, dated June 3, 2002.

Accordingly, prior to any further action on the merits, we encourage the examiner to consider MPEP § 706.03(k) and to take appropriate action.

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<sup>5</sup> Claims 27-29 as they now appear on this record were first entered in the July 8, 2002 amendment filed together with appellants' Request for Continuing Examination (RCE).

<sup>6</sup> Accordingly, we disagree with appellants' statement (Brief, page 2), "all amendments filed in this case on or before March 18, 2003, have been entered and considered."

**2. Prior art polymers:**

As we understand appellants' disclosure (specification, page 11), grafted silicone polymers within the scope of the claimed invention "are sold in particular by the Company 3M under the trade names VS70, VS80 and LO21." Prior to any further action on the merits, the examiner should consider if the grafted silicone polymers sold under the trade names VS70, VS80 and LO21 are prior art against the claimed invention either alone or in combination with other available prior art. See also Examples 1-6 of appellants' specification (pages 16-19), which in addition to describing formulations with VS80, also describe formulations using Sepigel 305, sold by the Seppic company.

**3. Forming a film on the skin:**

We note that during prosecution the examiner presented a rejection under 35 U.S.C. § 103 over Sebag (U.S. Patent No. 6,162,423), in view of Sidhu (U.S. Patent No. 4,963,353). See Office Action, dated December 21, 2001. In an attempt to overcome this rejection, appellants asserted (page 7, Response, dated July 8, 2002), the compositions taught by Sebag "are only on skin briefly, no anti-aging (including anti-wrinkle) and/or tightening effect can be obtained, primarily because no film is formed on the skin. Because no such effects are obtained, no reduction or removal of signs of aging (including wrinkles) can occur." Upon consideration of the claims presented for our review, we note that claims 27-29 are the only claims which require that the composition "remain on the skin after said applying, thereby forming a film." Based on appellants' earlier

comments with regard to the Sebag reference, it would appear that to obtain a reduction in the signs of aging (including wrinkles), the composition set forth in each of appellants claims would need to remain on the skin long enough to form a film.

Prior to any further action on the merits, we encourage the examiner to reconsider the prosecution history together with appellants' specification and any relevant prior art, to determine if appellants' specification provides an enabling disclosure of the invention commensurate in scope with those claims that do not require that the composition be retained on the skin for any specific period of time. In addition, we also encourage the examiner to reconsider whether Sebag is relevant prior art against those claims that do not require that the composition remain on the skin to form a film.

REMANDED

  
William F. Smith  
Administrative Patent Judge

  
Donald E. Adams  
Administrative Patent Judge

  
Eric Grimes  
Administrative Patent Judge

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